

REMARKS

In the Office Action mailed on March 31, 2005, the Examiner rejected claims 1, 4, 8, 11, and 12 under 35 U.S.C. § 101; rejected claims 1-24 and 26 under 35 U.S.C. § 112, second paragraph as being vague and indefinite; rejected claims 1, 8, 9, 13, and 21 under 35 U.S.C. § 102(b) as being anticipated by the E-Benefits Inc. website ("E-Benefits"); rejected claims 2 and 14 under 35 U.S.C. § 103(a) as being unpatentable over E-Benefits in view of Singerman (Singerman, Frederic S. "The Impact of the Electronic Signature Act on Plan Administration," Journal of Pension Benefits: Issues in Administration, August 2000, Vol. 8, Issue 1, pp. 3-8); rejected claims 3, 4, 5, 15, 16, and 17 under 35 U.S.C. § 103(a) as being unpatentable over E-Benefits in view of MacSweeney (MacSweeney, Gregory, "Billing System Drives Cross-Sell Efforts," Insurance & Technology, June 2003, Vol. 28, Issue 6, pg. 23); rejected claims 6-7 and 18-19 under 35 U.S.C. § 103(a) as being unpatentable over E-Benefits and MacSweeney and further in view of Singerman; rejected claims 10 and 22 under 35 U.S.C. § 103(a) as being unpatentable over E-Benefits in view of Microsoft Mastering (Microsoft Mastering. E-Commerce Development: Business to Business, Microsoft Press, Redmond, Washington, 2000, Ch. 6: "Overview of the Extensible Markup Language [XML]"); rejected claims 11, 12, 23, and 24 under 35 U.S.C. § 103(a) as being unpatentable over E-Benefits in view of Thompson et al. (U.S. Patent Publication No. 2003/0229522); rejected claim 20 under 35 U.S.C. § 103(a) as being unpatentable over E-Benefits in view of Franklin et al. (U.S. Patent Publication No. 2004/0172268); and rejected claims 25 and 26 under 35 U.S.C. § 103(a) as being unpatentable over E-Benefits in view of Gupta (U.S. Patent Publication No. 2003/0009355).

By the above amendment, Applicant has amended independent claims 1, 13, 25, and 26 and added new claims 27-30 to clarify the claimed invention. Claims 1-30 remain pending. Applicant respectfully submits that no new matter has been added by these amendments. Further, based on the following reasoning, Applicant respectfully traverses those rejections and request allowance of the present application.¹

I. The Rejection of Claims 1, 4, 8, 11, and 12, Under 35 U.S.C. § 101

With regard to the rejection under 35 U.S.C. § 101, the Examiner asserts that claims 1, 4, 8, 11, 12, are directed to non-statutory subject matter because the claims “only actions . . . or provide a definition for a specific composition of benefits being sought.”² (See OA at 2-3.) Further, the Examiner asserts that “[e]ach of these could be done without the use of technology.” (*Id.*).

Although Applicant disagrees with the Examiner’s position and believes that such features are inherent, Applicant has amended claim 1 to recite a computer-implemented method wherein preparing a search message including the requirements for benefits and a predetermined number is done “electronically.” Accordingly, Applicant respectfully requests the Examiner to withdraw the rejections of claims 1, 4, 8, 11, and 12 under 35 U.S.C. § 101.

¹ As Applicant’s remarks with respect to the Examiner’s rejections are sufficient to overcome these rejections, Applicant’s silence as to certain assertions or requirements applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, etc.) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such in the future.

² The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

II. The Rejection of Claims 1-24 and 26, Under 35 U.S.C. § 112

With regard to the rejection under 35 U.S.C. § 112, the Examiner asserts that:

[i]n exemplary claim 1, it is clear that certain pieces of information (e.g. “requirements”, “authorization”) are to be received from an employer and transmitted to a benefits provider(s). “Bids” however, are only received from the benefits provider. Without a step of transmitting the bids to the employer, it is unclear what basis an employer would have for making an authorization. Similar analysis holds for claims 13 and 26.

(OA at 3.) Although Applicant disagrees with the Examiner’s position, Applicant has amended claims 1, 13, and 26 to recite “transmitting the bids,” as suggested by the Examiner. Accordingly, Applicant requests the Examiner to withdraw the rejection of claims 1-24 and 26 under 35 U.S.C. § 112.

III. The Rejection of Claims 1, 8, 9, 13, and 21 Under 35 U.S.C. § 102(b)

Claims 1, 8, 9, 13, and 21 were rejected under 35 U.S.C. 102(b) as being anticipated by E-Benefits. Applicant respectfully traverses these rejections.

In order to support a rejection under 35 U.S.C. § 102(b), each and every element as set forth in the claims must be found, either expressly or inherently described, in a single prior art reference. M.P.E.P. § 2131. E-Benefits fails to teach each and every recitation of claims 1, 8, 9, 13, and 21.

Claim 1 recites a combination including *inter alia*, “electronically preparing a search message including the requirements for benefits and a number of nodes for the search” and “transmitting the search message only to a select number of benefits providers based on the number of nodes.” E-Benefits fails to teach these limitations.

In contrast, E-Benefits discloses a QuoteWizard wherein the user can “search criteria” and the “Quote Wizard will instantly search hundreds of California health, dental, and vision plans finding benefits that meet your company’s needs.” (E-Benefits,

page 3.) However, E-Benefits is silent as to “electronically preparing a search message including the requirements for benefits and a number of nodes for the search” and “transmitting the search message only to a select number of benefits providers based on the number of nodes,” as recited in claim 1. As such, Applicant respectfully submits that claim 1 is allowable over E-Benefits and requests the Examiner to withdraw the rejection of claim 1.

Claim 13, although of different scope, recites elements similar to that discussed above with regard to claim 1. Applicant, therefore, requests the Examiner to withdraw the rejection of claim 13 for at least the same reasons discussed above with respect to claim 1.

Claims 8, 9, and 21 depend from claims 1 and 13, respectively. As explained, claims 1 and 13 recite elements not disclosed by E-Benefits. Accordingly, claims 8, 9, and 21 are allowable over E-Benefits for at least the same reasons as claims 1 and 13.³ Applicant, therefore, respectfully requests that the rejection of these claims under 35 U.S.C. § 102(b) be withdrawn and the claims allowed.

IV. The Rejection of Claims 2 and 14 Under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 2 and 14 because the Examiner has failed to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all

³ As Applicant's remarks with respect to the base independent claims are sufficient to overcome the Examiner's rejection of all claims dependent therefrom, Applicant's silence as to the Examiner's assertions with respect to dependent claims is not a concession by Applicant to the Examiner's assertions as to these claims, and Applicant reserve the right to analyze and dispute such assertions in the future.

the claim elements. Furthermore, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." See M.P.E.P. § 2143.01 (8th Ed., Aug. 2001), quoting In re Wilson, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. See M.P.E.P. § 2143 (8th Ed. 2001), pp. 2100-122 to 127.

Claims 2 and 14 depend from claims 1 and 13, respectively. As explained, claims 1 and 13 recite elements that are neither disclosed nor suggested by E-Benefits. Accordingly, claims 2 and 14 are allowable over E-Benefits for at least the same reasons as claims 1 and 13.⁴ Applicant, therefore, respectfully requests that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

Moreover, Singerman does not cure the deficiencies of E-Benefits. That is, the Examiner cited Singerman only for its alleged teaching of receiving an electronic signature from the employer. Singerman does not teach "electronically preparing a search message including the requirements for benefits and a number of nodes for the search" and "transmitting the search message only to a select number of benefits providers based on the number of nodes," as recited in claims 1 and 13. Therefore,

⁴ As Applicant's remarks with respect to the base independent claims are sufficient to overcome the Examiner's rejection of all claims dependent therefrom, Applicant's silence as to the Examiner's assertions with respect to dependent claims is not a concession by Applicant to the Examiner's assertions as to these claims, and Applicant reserves the right to analyze and dispute such assertions in the future.

Applicant submits that these claims are allowable and request the Examiner to withdraw the rejections of claims 2 and 14.

V. The Rejection of Claims 3, 4, 5, 15, 16, and 17 Under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 3, 4, 5, 15, 16, and 17 because the Examiner has failed to establish a *prima facie* case of obviousness.

Claims 3, 4, 5, 15, 16, and 17 depend from claims 1 and 13, respectively. As explained, claims 1 and 13 recite elements that are neither disclosed nor suggested by E-Benefits. Accordingly, claims 3, 4, 5, 15, 16, and 17 are allowable over E-Benefits for at least the same reasons as claims 1 and 13.⁵ Applicant, therefore, respectfully requests that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

Moreover, MacSweeney does not cure the deficiencies of E-Benefits. That is, the Examiner has also failed to show where MacSweeney teaches “electronically preparing a search message including the requirements for benefits and a number of nodes for the search” and “transmitting the search message only to a select number of benefits providers based on the number of nodes,” as recited in claims 1 and 13.

Therefore, Applicant submits that these claims are allowable and request the Examiner to withdraw the rejections of claims, 3, 4, 5, 15, 16, and 17.

⁵ As Applicant’s remarks with respect to the base independent claims are sufficient to overcome the Examiner’s rejection of all claims dependent therefrom, Applicant’s silence as to the Examiner’s assertions with respect to dependent claims is not a concession by Applicant to the Examiner’s assertions as to these claims, and Applicant reserves the right to analyze and dispute such assertions in the future.

VI. The Rejection of Claims 6-7 and 18-19 Under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 6-7 and 18-19 because the Examiner has failed to establish a *prima facie* case of obviousness.

Claims 6-7 and 18-19 depend from claims 5 and 17, respectively. As explained, claims 5 and 17 recite elements that are neither disclosed nor suggested by E-Benefits and MacSweeney. Accordingly, claims 6-7 and 18-19 are allowable over E-Benefits and MacSweeney for at least the same reasons as claims 5 and 17.⁶ Applicant, therefore, respectfully requests that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

Moreover, Sinegrman, as discussed above, does not cure the deficiencies of E-Benefits and MacSweeney. Accordingly, Applicant submits that these claims are allowable and request the Examiner to withdraw the rejections of claims, 6-7 and 18-19.

VII. The Rejection of Claims 10 and 22 Under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 10 and 22 because the Examiner has failed to establish a *prima facie* case of obviousness.

Claims 10 and 22 depend from claims 9 and 21, respectively. As explained, claims 9 and 21 recite elements that are neither disclosed nor suggested by E-Benefits. Accordingly, claims 10 and 22 are allowable over E-Benefits for at least the same

⁶ As Applicant's remarks with respect to the base independent claims are sufficient to overcome the Examiner's rejection of all claims dependent therefrom, Applicant's silence as to the Examiner's assertions with respect to dependent claims is not a concession by Applicant to the Examiner's assertions as to these claims, and Applicant reserves the right to analyze and dispute such assertions in the future.

reasons as claims 9 and 21.⁷ Applicant, therefore, respectfully requests that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

Moreover, Microsoft Mastering does note cure the deficiencies of E-Benefits. That is, the Examiner has also failed to show where Microsoft Mastering teaches “electronically preparing a search message including the requirements for benefits and a number of nodes for the search” and “transmitting the search message only to a select number of benefits providers based on the number of nodes,” as recited in claims 1 and 13. Therefore, Applicant submits that these claims are allowable and request the Examiner to withdraw the rejections of claims, 10 and 22.

VIII. The Rejection of Claims 11-12 and 23-24 Under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 11-12 and 23-24 because the Examiner has failed to establish a *prima facie* case of obviousness.

Claims 11-12 and 23-24 depend from claims 1 and 13, respectively. As explained, claims 1 and 13 recite elements that are neither disclosed nor suggested by E-Benefits. Accordingly, claims 11-12 and 23-24 are allowable over E-Benefits for at least the same reasons as claims 1 and 13.⁸ Applicant, therefore, respectfully requests

⁷ As Applicant's remarks with respect to the base independent claims are sufficient to overcome the Examiner's rejection of all claims dependent therefrom, Applicant's silence as to the Examiner's assertions with respect to dependent claims is not a concession by Applicant to the Examiner's assertions as to these claims, and Applicant reserves the right to analyze and dispute such assertions in the future.

⁸ As Applicant's remarks with respect to the base independent claims are sufficient to overcome the Examiner's rejection of all claims dependent therefrom, Applicant's silence as to the Examiner's assertions with respect to dependent claims is not a concession by Applicant to the Examiner's assertions as to these claims, and Applicant reserves the right to analyze and dispute such assertions in the future.

that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

Moreover, Thompson et al. does not cure the deficiencies of E-Benefits. That is, the Examiner has also failed to show where Thompson et al. teaches “electronically preparing a search message including the requirements for benefits and a number of nodes for the search” and “transmitting the search message only to a select number of benefits providers based on the number of nodes,” as recited in claim 1. Therefore, Applicant submits that these claims are allowable and request the Examiner to withdraw the rejections of claims 11-12 and 23-24.

IX. The Rejection of Claim 20 Under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claim 20 because the Examiner has failed to establish a *prima facie* case of obviousness.

Claim 20 depends from claim 13. As explained, claim 13 recites elements that are neither disclosed nor suggested by E-Benefits. Accordingly, claim 20 is allowable over E-Benefits for at least the same reasons as claim 13.⁹ Applicant, therefore, respectfully requests that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

Moreover, Franklin et al. does not cure the deficiencies of E-Benefits. That is, the Examiner has also failed to show where Franklin et al. teaches “electronically preparing a search message including the requirements for benefits and a number of nodes for the search” and “transmitting the search message only to a select number of benefits providers based on the number of nodes,” as recited in claim 13. Therefore, Applicant submits that these claims are allowable and request the Examiner to withdraw the rejection of claim 20.

X. The Rejection of Claims 25-26 Under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 25-26 because the Examiner has failed to establish a *prima facie* case of obviousness.

Claim 25 and 26, although of different scope, recite elements similar to that discussed above with regard to claim 1. As explained, claim 1 recites elements that are

⁹ As Applicant’s remarks with respect to the base independent claims are sufficient to overcome the Examiner’s rejection of all claims dependent therefrom, Applicant’s silence as to the Examiner’s assertions with respect to dependent claims is not a concession by Applicant to the Examiner’s assertions as to these claims, and Applicant reserves the right to analyze and dispute such assertions in the future.

neither disclosed nor suggested by E-Benefits. Accordingly, claims 25-26 are allowable over E-Benefits for at least the same reasons as claim 1.¹⁰ Applicant, therefore, respectfully requests that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

Moreover, Gupta does not cure the deficiencies of E-Benefits. That is, the Examiner has also failed to show where Gupta teaches “electronically preparing a search message including the requirements for benefits and a number of nodes for the search” and “transmitting the search message only to a select number of benefits providers based on the number of nodes,” as recited in claim 1. Therefore, Applicant submits that these claims are allowable and request the Examiner to withdraw the rejections of claims 25-26.

XI. Conclusion

In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of all of the pending claims 1-30.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

¹⁰ As Applicant's remarks with respect to the base independent claims are sufficient to overcome the Examiner's rejection of all claims dependent therefrom, Applicant's silence as to the Examiner's assertions with respect to dependent claims is not a concession by Applicant to the Examiner's assertions as to these claims, and Applicant reserves the right to analyze and dispute such assertions in the future.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

A handwritten signature in black ink, appearing to be 'C. Gramenopoulos', written over a horizontal line.

Dated: August 30, 2005

By: _____
C. Gregory Gramenopoulos
Reg. No. 36,532